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*In re* Application of Stanfield et al

Appl. No.: 08/998,302

Filed: December 24, 1997

For: ELECTRONIC SYSTEM, COMPONENTS AND METHOD:  
FOR TRACKING FILES

**DECISION ON PETITION**

This is a decision on the petition, filed October 13, 1998, to withdraw the restriction requirement made in the office action, mailed June 8, 1998. The Office regrets the delay in responding to this petition.

A review of the prosecution history indicates the following:

During the prosecution of parent application 08/379,944, the examiner made a six way restriction requirement. Applicant elected one group and argued that the examiner should join that group with another. The examiner agreed. The elected groups included claims directed to the concept of file tracking and locating classified in classes 364 and 340. The parent application subsequently issued, and applicant filed a continuation, which is this application.

On June 8, 1998, the examiner made an eight way restriction requirement. Groups I, II, III, and VIII were related as subcombinations usable together, and Groups IV, V, VI, and VII were separate species of the claimed retainer. On July 6, 1998, applicant filed a response with an election and arguments to withdraw or modify the original restriction requirement. A subsequent office action was mailed on August 31, 1998 maintaining the requirement and including an action on the merits to the elected claims. This petition was then filed on October 13, 1998.

To properly establish whether claims are restrictable, the examiner must consider all of the limitations of the claims. The limitations of a dependent claim would include the limitations of any parent claim in the chain of dependency. When drafting a proper restriction requirement under MPEP 806.05(d), the examiner must establish one-way distinctness for the claims, as

grouped, and must do so while taking into consideration all of the limitations of any parent claim. The June 8, 1998 restriction requirement failed to consider some of the parent claims when establishing one-way distinctness. For example, the examiner listed claims 2-6 and 24-33 as part of Group I, and claims 7-10, 61, and 62 as part of Group II. The examiner did not list independent claims 1, 19, and 23 as claims that were in these groups, but, later in the restriction requirement, indicated that the aforementioned claims would be examined if either group was elected.

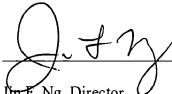
Furthermore, the examiner indicated that the subcombination of Group VIII had separate utility from the other groups. The examiner failed to establish that any of Groups I, II, and III had separate utility from each other. While MPEP 806.05(d) requires only one-way distinctness, this distinctness must be established between any two groups. Since there was no separate utility established among all the groups, the restriction is not deemed to be proper.

The restriction requirement also failed to indicate any distinctness between Groups I, II, III, and VIII, and the remaining Groups IV, V, VI, and VII, which were part of the election of species requirement. The restriction requirement listed the species Groups IV, V, VI, and VII separate from the subcombination Groups I, II, III, and VIII without establishing how the species groups were restrictable from the subcombination groups. If Groups IV-VII are determined to be distinct, a species requirement should then be made up on election of any of Groups IV-VII for examination.

The restriction requirement also failed to establish how the plural claimed inventions presented a burden on the examiner with respect to searching, since the present claimed invention is similar to the claims and groups elected during the prosecution of the parent application, especially in view of the fact that the examiner already indicated claims 1, 19, and 23 will be examined with any elected group.

For the reasons stated above, the petition is Granted.

It is noted that, on February 4, 1999, petitioner filed a response to the August 31, 1998 office action. That amendment will be entered. This application will then be forwarded back to the examiner for a new non-final action on the merits. The examiner is not barred from again making another restriction requirement, but any future requirement must be in compliance with current established practice as identified in this decision.

  
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